

II. Nonstatutory Double Patenting Rejection

Applicants respectfully acknowledge the Examiner's withdrawal of the previous rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting over claim 89 of U.S. Patent No. 6,602,303 B2. Applicants also acknowledge the Examiner's withdrawal of the previous rejections under 35 U.S.C. §§102 and 103.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner newly rejects claims 1-17 and 24-59 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Laurent et al. (US 2002/0046431 A1) (hereinafter "*Laurent*") in view of Cottard et al. (US 2001/0023514 A1) (hereinafter "*Cottard*"). See Office Action at 2.

According to the Examiner, *Laurent* "teaches a hair dyeing composition comprising at least one oxidation dye (see page 1, paragraph, 0019), C10-C14 fatty alcohol (see page 10, paragraph, 0249), cationic poly(vinyl lactam) polymers formed from a) monomers of vinyl lactam and monomers of alkyvinyl lactum [sic] monomers, at least one monomer chosen from formulae (Ib) and (IIb) which are similar to the claimed formulae (Ia) and (Ib) as claimed in claims 1-2 and 5-8. . . " *Id.* The Examiner admits that the "instant claims differ from [*Laurent*] by reciting a dyeing composition comprising at least one nonpolyoxyalkyleneated C10-C14 fatty alcohol in the claimed amounts. Further, the claims differ by reciting at least one synthetic thickener." *Id.* at 4.

The Examiner then cites *Cottard* to attempt to cure the deficiencies of *Laurent*. The Examiner contends that *Cottard* "in analogous art of hair dyeing formulation,

teaches a composition comprising fatty alcohols such as lauryl and oleyl alcohols in the amounts of 0.001 to 20% (see page 17, paragraph , 0347) and synthetic thickeners (see page 3, paragraph 0049). Office Action at 5. The Examiner concludes that "one having ordinary skill in the art at the time the invention was made would have been motivated to modify the dyeing composition of Laurent . . . by replacing the oleyl alcohol with lauryl alcohol and incorporating the synthetic thickeners as taught by Cottard." *Id.*

The Examiner attempts to support this obviousness contention with the rationale that *Laurent* "as a primary reference suggests the use of thickeners and fatty alcohols in the dyeing composition," and *Cottard* "as a secondary reference clearly teaches the equivalence between oelyl [sic] and luuryl [sic] fatty alcohols in the dyeing composition and also teaches synthetic thickeners." *Id.* The Examiner further contends that "a person of ordinary skill in the art would be motivated to incorporate these dyeing ingredients as taught . . . with a reasonable expectation of success to arrive at the claimed invention and would expect such a composition to have similar properties to those claimed, absent unexpected results." *Id.*

Applicants respectfully traverse this rejection because the Examiner has failed to establish, as required by M.P.E.P. § 2143, a prima facie showing of obviousness. For a prima facie case of obviousness to be established, the teaching or suggestion to make a claimed combination of elements must be found in the prior art, **not in applicant's disclosure**. See *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (emphasis added). The Examiner "must show reasons that the skilled

artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (emphasis in original) (citations omitted).

The presently claimed invention recites, in relevant part, a “composition for the oxidation dyeing of keratin fibers, comprising . . . at least one nonpolyoxyalkylenated C₁₀-C₁₄ fatty alcohol.” See, e.g., claim 1 (emphasis added). In trying to show motivation to arrive at the presently claimed invention, the Examiner first asserts that *Laurent* “suggest[s] the use of thickeners and fatty alcohols in the dyeing composition.” Office Action at 5. However, as the Examiner admits, *Laurent* does not teach or suggest the use or desirability of nonpolyoxyalkylenated C₁₀-C₁₄ fatty alcohols. In fact, *Laurent* teaches only oxyalkylenated and glycerolated fatty alcohols, and does not even discuss the number of carbons. Such a disclosure in *Laurent* actually teaches away from, rather than motivates the use of, the presently claimed nonpolyoxyalkylenated C₁₀-C₁₄ fatty alcohols. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (emphasis added).

The Examiner further asserts that *Cottard* teaches the equivalence between oleyl and lauryl fatty alcohols. Such an assertion is not accurate when one considers the entire teaching of *Cottard*. In reality, *Cottard* teaches a dyeing composition that comprises, in part, at least one monoglycerolated or polyglycerolated fatty alcohol. The portion of *Cottard* the Examiner relies on for teaching “equivalence” between oleyl and lauryl fatty alcohols merely teaches that the compositions of *Cottard* may further optionally comprise an additional fatty alcohol, in addition to the at least one monoglycerolated or polyglycerolated fatty alcohol. Therefore, *Cottard* does not teach the equivalence of polyoxyalkylenated and nonpolyoxyalkylenated C₁₀-C₁₄ fatty alcohols, as the Examiner is trying to imply, but rather *Cottard* suggests that oleyl and lauryl fatty alcohols should be used only in conjunction with at least one monoglycerolated or polyglycerolated fatty alcohol. Thus, there is no motivation in either *Laurent* or *Cottard* to replace the oleyl alcohol of *Laurent* with the lauryl alcohol of *Cottard*, nor is there motivation to arrive at the presently claimed invention.

The Federal Circuit has stated that “[f]ocusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness.” *Gillette Co. v. S.C. Johnson & Son, Inc.* 919 F.2d 720, 724, 16 U.S.P.Q.2d 1923, 1927 (Fed. Cir. 1990) (citing *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 U.S.P.Q. 81, 93 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947, 107 S.Ct. 1606, 94 L.Ed.2d 792 (1987)). In *Gillette*, the obviousness of a combination of two references

which resulted in the substitution of a water-soluble gelling agent (e.g., cellulose) for an oil-soluble gelling agent (aluminum octoate) in a shaving gel was at issue. The Federal Circuit, looking at the prior art as a whole, stated that the “closest prior art ... would likely *discourage* the art worker from attempting the substitution” because “[c]ontrary to the district court’s understanding, water-soluble polymers would not serve this purpose in [the prior art] composition.” *Gillette* 919 F.2d at 724, 16 U.S.P.Q.2d at 1927. The claimed composition was determined to be non-obvious by the Federal Circuit, even though each component of the claimed combination was separately known in the prior art, because “[w]hat was not known or suggested ... was the composition that resulted from the combination of those components, and its unique properties.” *Id.* at 725, 16 U.S.P.Q.2d at 1928. The court explicitly rejected the argument that “other art-recognized advantages of cellulose-based polymers, namely lubricity and consistency enhancement, provide the ‘suggestion’ sufficient to motivate the art worker to substitute them for Bluard’s aluminum octoate,” concluding, “[t]his theory boils down to no more than hindsight reconstruction.” *Id.* at 726, 16 U.S.P.Q.2d at 1929.

Here too, the Examiner is relying on improper hindsight reconstruction to combine the teachings of *Laurent* and *Cottard*. The Federal Circuit has held that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). As shown above, the Examiner is focusing on the obviousness of substitutions and differences between *Laurent*, *Cottard* and the

claimed invention, rather than considering the claimed invention as a whole, as well as the teachings of *Laurent* and *Cottard* as a whole.

Accordingly, Applicants respectfully assert that this rejection is in error and should be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants submit that the pending claims are not anticipated or obvious in view of the prior art reference cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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